ESTTA Tracking number:

ESTTA784679

Filing date:

11/22/2016

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Vale National Training Center, Inc.
Granted to Date of previous extension	02/08/2017
Address	2424 E. Randol Mill Road Arlington, TX 76011 UNITED STATES

Attorney informa-	George R. Schultz
tion	Schultz & Associates, P.C.
	5400 LBJ Freeway Suite 1200
	Dallas, TX 75240
	UNITED STATES
	rschultz@grspc.com, nmarsh@grspc.com, docket@grspc.com, kneed-
	ham@grspc.com Phone:214-210-5940

Applicant Information

Application No	86923011	Publication date	10/11/2016
Opposition Filing Date	11/22/2016	Opposition Peri- od Ends	02/08/2017
Applicant	Vale Insurance Partners 2920 W. Coyle Ave Chicago, IL 606452924 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2016/01/08 First Use In Commerce: 2016/01/08

All goods and services in the class are opposed, namely: Insurance services, namely, a managing general agency that engages in the solicitation, brokering, underwriting, issuance, and administration of property insurance and casualty insurance products, onan admitted and non-admitted basis, on behalf of insurance carriers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3782029	Application Date	08/29/2008
Registration Date	04/27/2010	Foreign Priority Date	NONE

Word Mark	VALE TRAINING SOLUTIONS
Design Mark	VALE TRAINING SOLUTIONS
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 2008/09/00 First Use In Commerce: 2008/09/00
	Education services, namely, training and courses in the fields of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property, casualty, workers compensation, legal liability, adjuster and agent licensing, professionaldevelopment, professional designations,OSHA and healthcare

U.S. Registration No.	3782028	Application Date	08/29/2008	
Registration Date	04/27/2010	Foreign Priority Date	NONE	
Word Mark	VALE TRAINING SOLUTION	S		
Design Mark	Vale Training Solutions			
Description of Mark	The mark consists of the terms "VALE TRAINING SOLUTIONS" and a shaded circle containing a chain link.			
Goods/Services	Class 041. First use: First Use: 2008/09/00 First Use In Commerce: 2008/09/00			
	Education services, namely, training and courses in the fields of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property, casualty, workers compensation, legal liability, adjuster and agent licensing, professionaldevelopment, professional designations, OSHA and healthcare			

U.S. Registration No.	2255689	Application Date	06/15/1998
Registration Date	06/22/1999	Foreign Priority Date	NONE
Word Mark	VALE NATIONAL		

Design Mark	Vale National
Description of Mark	NONE
Goods/Services	Class 041. First use: First Use: 1979/00/00 First Use In Commerce: 1979/00/00
	Education services, namely, training inthe field of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property

Attachments	77558795#TMSN.png(bytes)
	77558790#TMSN.png(bytes)
	75502876#TMSN.png(bytes)
	Notice of Opposition .0209 112216.pdf(1822157 bytes)

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/george r. schultz/		
Name	George R. Schultz		
Date	11/22/2016		

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of Trademark

Application Serial No.: 86/923,011

For the mark: VALE INSURANCE PARTNERS and design

Published in the Official Gazette on: October 11, 2016

VALE NATIONAL TRAINING CENTER, INC.,

Opposer,

v.

VALE INSURANCE PARTNERS LLC,

Applicant.

NOTICE OF OPPOSITION

OPPOSITION NO.

Vale National Training Center, Inc. ("Opposer") believes that it has been and will be damaged by registration of the mark shown in Application No. 86/923,011 (the "Application"), and therefore files this Notice of Opposition pursuant to 15 U.S.C. § 1063, and would respectfully show the Board the following:

I. Parties

- Opposer is a Texas corporation having a principal place of business at 2424 E.
 Randol Mill Road, Arlington, Texas 76011.
- 2. Vale Insurance Partners LLC ("Applicant") is an Illinois limited liability company having an address of 2920 W. Coyle Ave., Chicago, Illinois 60645. The correspondent of record for Applicant is Paul C. Llewellyn of Kaye Scholer LLP at 250 West 55th Street, New York, New York 10019.

II. Standing

- 3. Opposer owns incontestable U.S. Registration No. 3,782,029 for the mark "VALE TRAINING SOLUTIONS" for use in association with "education services, namely, training and courses in the fields of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property, casualty, workers compensation, legal liability, adjuster and agent licensing, professional development, professional designations, OSHA and healthcare" in international class 41. The mark was registered on April 27, 2010. The Registration is valid and subsisting. The date of first use cited in the Registration is September 2008. A copy of U.S. Registration No. 3,782,029 is attached as Exhibit A. A printout from the USPTO's TSDR database for Registration No. 3,782,029 is attached as Exhibit B.
- 4. Opposer owns incontestable U.S. Registration No. 3,782,028 for the mark "VALE TRAINING SOLUTIONS" and design for use in association with "education services, namely, training and courses in the fields of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational vehicles and all forms of property, casualty, workers compensation, legal liability, adjuster and agent licensing, professional development, professional designations, OSHA and healthcare" in international class 41. The mark was registered on April 27, 2010. The Registration is valid and subsisting. The date of first use cited in the Registration is September 2008. A copy of U.S. Registration No. 3,782,028 is attached as Exhibit C. A printout from the USPTO's TSDR database for Registration No. 3,782,028 is attached as Exhibit D.
- 5. Opposer owns incontestable U.S. Registration No. 2,255,689 for the mark "VALE NATIONAL" and design for use in association with "education services, namely, training in the field of appraising damage to automobiles, trucks, heavy equipment, mobile homes, recreational

vehicles and all forms of property" in international class 41. The mark was registered on June 22, 1999. The Registration is valid and subsisting. The date of first use cited in the Registration is 1979. A copy of U.S. Registration No. 2,255,689 is attached as Exhibit E. A printout from the USPTO's TSDR database for Registration No. 2,255,689 is attached as Exhibit F.

- 6. The marks shown in Registration Nos. 3,782,029, 3,782,028, and 2,255,689 are hereinafter collectively referred to as "Opposer's Marks." The services listed in Opposer's Registration Nos. 3,782,029, 3,782,028, and 2,255,689 are hereinafter collectively referred to as "Opposer's Services."
- 7. Since before the date of filing of the Application, Opposer adopted and used Opposer's Marks in association with Opposer's Services. Opposer has continuously sold its services under Opposer's Marks since the adoption of the marks.
- 8. Opposer has expended substantial amounts of money, time, and effort in advertising and promoting Opposer's Marks. The trade and purchasing public have come to know and recognize Opposer's Marks and the associated services as being those of Opposer and that these services originate with Opposer. Hence, Opposer's Marks identify Opposer as the source of Opposer's Services and distinguishes those services from those of others.
 - 9. Opposer's Marks are inherently distinctive or have acquired secondary meaning.
- 10. By virtue of the excellent and consistent quality of the services sold under Opposer's Marks, Opposer has become well known and has acquired an excellent reputation for the services sold in connection with Opposer's Marks. Opposer's Marks are symbolic of the goodwill and consumer recognition established by Opposer and indicative of its reputation for excellence in the industry.

- 11. On information and belief, Applicant has adopted the mark "VALE INSURANCE PARTNERS" and design ("Applicant's Mark") for use in association with "insurance services, namely, a managing general agency that engages in the solicitation, brokering, underwriting, issuance, and administration of property insurance and casualty insurance products, on an admitted and non-admitted basis, on behalf of insurance carriers" ("Applicant's Services") in international class 36. An application to register Applicant's Mark was filed on February 29, 2016. The Application was filed under Section 1(a) as a use based application with a stated date of first use of January 8, 2016. The Applicant's Mark was published for opposition on October 11, 2016.
- 12. On November 10, 2016, Opposer requested a ninety (90) day extension of time, or until February 8, 2017, to oppose registration of Applicant's Mark. Opposer's request was granted on November 10, 2016.

III. Grounds

<u>Likelihood of Confusion 15 U.S.C. § 1052(d)</u>

- 13. Under § 2(d) of the Act, 15 U.S.C. § 1052(d), Applicant's Mark so resembles Opposer's Marks, previously used in the United States and registered with the USPTO by Opposer and not abandoned, as to be likely, when used on or in connection with Applicant's Services, to cause confusion, to cause mistake or to deceive.
- 14. Applicant's Mark is confusingly similar to Opposer's Marks. The similarity in sight, sound, and appearance between Opposer's Marks, and Applicant's Mark creates a similar or identical commercial impression.
- 15. The description of services in the Application is similar to Opposer's Services at least to the extent that both are rendered in the insurance industry.

IV. Damage

16. Opposer has superior rights in Opposer's Marks as compared to those of Applicant since Opposer has used Opposer's Marks in commerce continuously and prior to the filing of the Application and prior to Applicant's stated date of first use. Consequently, confusion, mistake or deception in the trade and in the minds of the consuming public between Opposer and Applicant as to the origin of Applicant's Services is likely to occur and be exacerbated with resulting damage to Opposer if the mark shown in the Application is allowed to be registered.

V. Fees

- 17. Pursuant to 37 C.F.R. 2.6(a)(17), the required fee of three hundred dollars (\$300.00) is submitted herewith in conjunction with the filing of this Notice of Opposition in one class, class 36.
- 18. The Board is authorized to charge additional required amounts or issue any credits for overpayments to Deposit Account No. 50-2225.

WHEREFORE, Opposer prays that registration of the mark as shown in Application No. 86/923,011 be denied.

Dated: November 22, 2016.

Respectfully submitted,

George R. Schultz Texas Bar No. 17837500 Nicole R. Marsh Texas Bar No. 24044653

SCHULTZ & ASSOCIATES, P.C. 5400 LBJ Freeway Suite 1200 Dallas, Texas 75240 214-210-5940 telephone 214-210-5941 facsimile

ATTORNEYS FOR OPPOSER VALE NATIONAL TRAINING CENTER, INC.

CERTIFICATE OF SERVICE

A true and correct copy of the foregoing Notice of Opposition was served upon the persons listed below in the manner indicated on November 22, 2016:

Mr. Paul C. Llewellyn Kaye Scholer LLP 250 West 55th Street New York, NY 10019 Via First Class Mail, Postage Prepaid

George R. Schultz

United States of America United States Patent and Trademark Office

VALE TRAINING SOLUTIONS

Reg. No. 3,782,029 VALE NATIONAL TRAINING CENTERS, INC. (TEXAS CORPORATION)

Registered Apr. 27, 2010 ARLINGTON, TX 76011

Int. Cl.: 41 FOR: EDUCATION SERVICES, NAMELY, TRAINING AND COURSES IN THE FIELDS OF

APPRAISING DAMAGE TO AUTOMOBILES, TRUCKS, HEAVY EQUIPMENT, MOBILE HOMES, RECREATIONAL VEHICLES AND ALL FORMS OF PROPERTY, CASUALTY, WORKERS COMPENSATION, LEGAL LIABILITY, ADJUSTER AND AGENT LICENSING, PROFESSIONAL DEVELOPMENT, PROFESSIONAL DESIGNATIONS, OSHA AND

PRINCIPAL REGISTER HEALTHCARE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 9-0-2008; IN COMMERCE 9-0-2008.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT STAYLE SIZE OR COLOR

TICULAR FONT, STYLE, SIZE, OR COLOR.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TRAINING SOLUTIONS", $\,$

APART FROM THE MARK AS SHOWN.

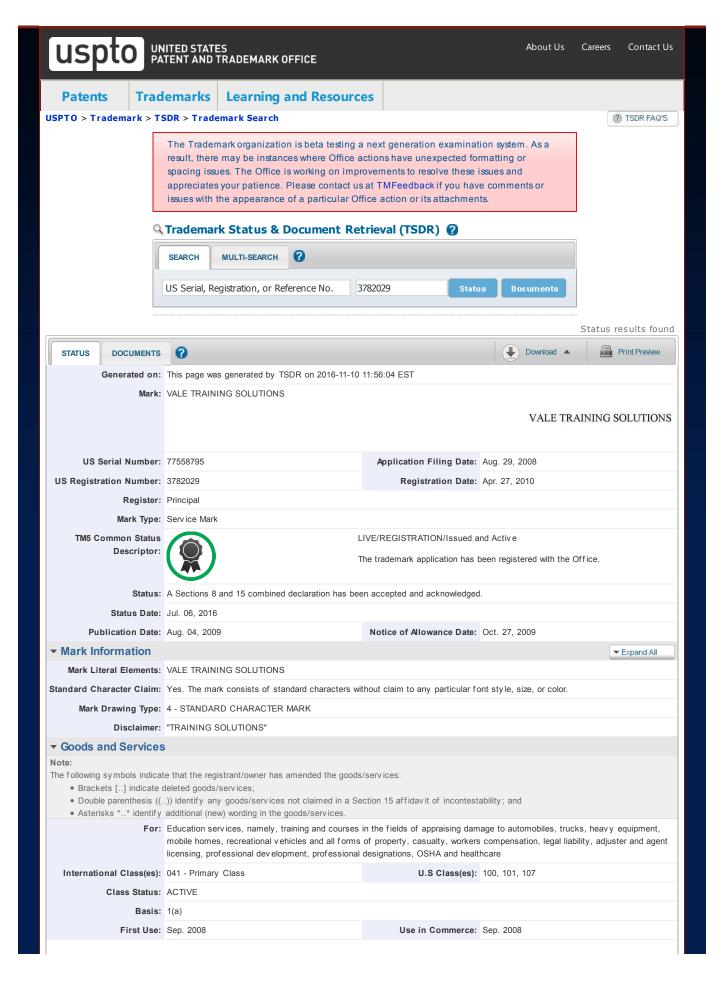
SN 77-558,795, FILED 8-29-2008.

TRACY CROSS, EXAMINING ATTORNEY



SERVICE MARK

Director of the United States Patent and Trademark Office



1 of 3 11/10/2016 10:58 AM

Basis Information (▼ Basis Information (Case Level)					
Filed Use:	No	Currently Use	e: Yes	Amended Use:	No	
Filed ITU:	Yes	Currently ITU	J: No	Amended ITU:	No	
Filed 44D:	No	Currently 44D): No	Amended 44D:	No	
Filed 44E:	No	Currently 44I	E: No	Amended 44E:	No	
Filed 66A:	No	Currently 66	A: No			
Filed No Basis:	No	Currently No Basis	s: No			
▼ Current Owner(s) In	nformation					
Owner Name:	Vale National Training Cen	ters, Inc.				
Owner Address:	2424 E Randol Mill Road Arlington, TEXAS UNITED	STATES 76011				
Legal Entity Type:	CORPORATION		State or Country Where Organized:	TEXAS		
▼ Attorney/Correspon	dence Information					
Attorney of Record						
Attorney Name:	George R. Schultz		Docket Number:	27831.0117		
Correspondent						
	GEORGE R. SCHULTZ SCHULTZ & ASSOCIATES 5400 LBJ FREEWAY SUITE 1200 DALLAS, TEXAS UNITED					
Phone:	214-210-5940		Fax:	214-210-5941		
Domestic Representative -	Not Found					
▲ Prosecution History	/					
▼ Maintenance Filings	▼ Maintenance Filings or Post Registration Information					
Affidavit of Continued Use:						
Affidavit of Incontestability:	Section 15 - Accepted					
▲ TM Staff and Location Information						
▲ Assignment Abstract Of Title Information						
▲ Proceedings - Click to Load						
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United States of America United States Patent and Trademark Office

Vale Training Solutions

Reg. No. 3,782,028 VALE NATIONAL TRAINING CENTERS, INC. (TEXAS CORPORATION)

Registered Apr. 27, 2010 ARLINGTON, TX 76011

Int. Cl.: 41 FOR: EDUC

SERVICE MARK

PRINCIPAL REGISTER

FOR: EDUCATION SERVICES, NAMELY, TRAINING AND COURSES IN THE FIELDS OF APPRAISING DAMAGE TO AUTOMOBILES, TRUCKS, HEAVY EQUIPMENT, MOBILE HOMES, RECREATIONAL VEHICLES AND ALL FORMS OF PROPERTY, CASUALTY, WORKERS COMPENSATION, LEGAL LIABILITY, ADJUSTER AND AGENT LICENSING, PROFESSIONAL DEVELOPMENT, PROFESSIONAL DESIGNATIONS, OSHA AND HEALTHCARE, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 9-0-2008; IN COMMERCE 9-0-2008.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "TRAINING SOLUTIONS", APART FROM THE MARK AS SHOWN.

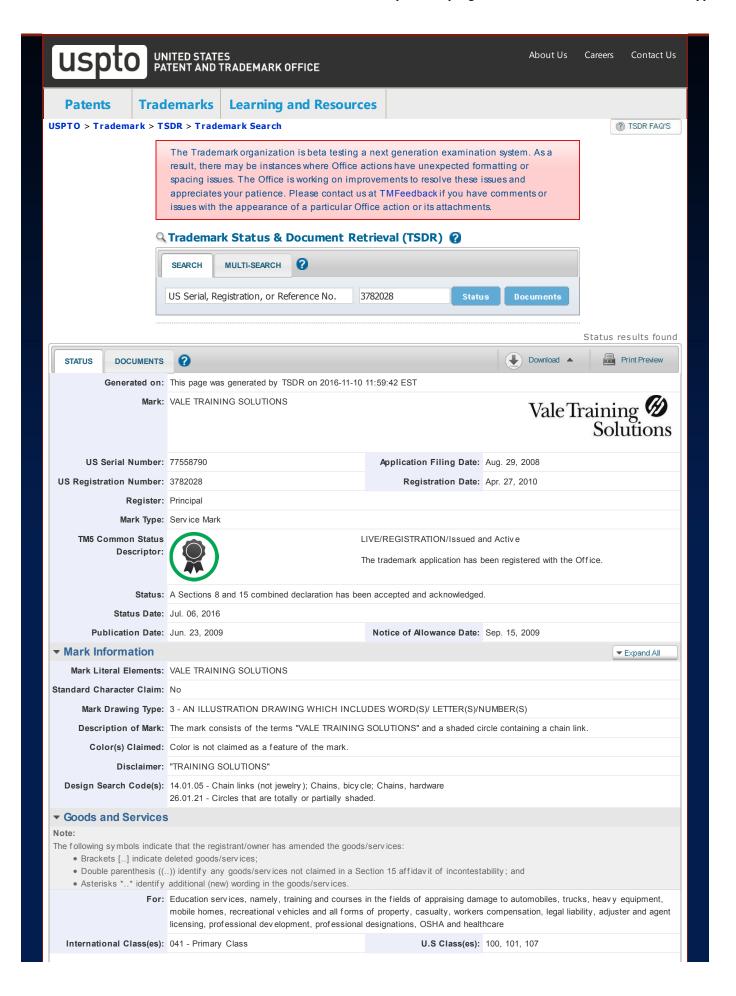
THE MARK CONSISTS OF THE TERMS "VALE TRAINING SOLUTIONS" AND A SHADED CIRCLE CONTAINING A CHAIN LINK.

SN 77-558,790, FILED 8-29-2008.

TRACY CROSS, EXAMINING ATTORNEY



Director of the United States Patent and Trademark Office



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Class Status:	ACTIVE								
Basis:	1(a)								
First Use:	Sep. 2008		Use in Commerce: Sep. 2008						
▼ Basis Information (Case Level)									
Filed Use:	No	Currently Us	e: Yes	Amended Use:	No				
Filed ITU:	Yes	Currently ITI	J: No	Amended ITU:	No				
Filed 44D:	No	Currently 44I): No	Amended 44D:	No				
Filed 44E:	No	Currently 44	≣: No	Amended 44E:	No				
Filed 66A:	No	Currently 66	A: No						
Filed No Basis:	No	Currently No Basi	s: No						
▼ Current Owner(s) Information									
Owner Name:	Vale National Training Centers, Inc.								
Owner Address:	2424 E Randol Mill Road Arlington, TEXAS UNITED STATES 76011								
Legal Entity Type:	CORPORATION		State or Country Where Organized:	TEXAS					
▼ Attorney/Correspondence Information									
Attorney of Record									
Attorney Name:	George R. Schultz		Docket Number: 27831.0118						
Correspondent									
· ·	GEORGE R. SCHULTZ SCHULTZ & ASSOCIATES, P.C. 5400 LBJ FREEWAY SUITE 1200 DALLAS, TEXAS UNITED STATES 75240								
Phone:	214-210-5940		Fax : 214-210-5941						
Domestic Representative - Not Found									
▲ Prosecution History									
▼ Maintenance Filings or Post Registration Information									
Affidavit of Continued Use:	Section 8 - Accepted								
Affidavit of Incontestability:	Section 15 - Accepted								
▲ TM Staff and Location Information									
▲ Assignment Abstract Of Title Information - Click to Load									
▲ Proceedings - Click to Load									
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Int. Cl.: 41

Prior U.S. Cls.: 100, 101 and 107

Reg. No. 2,255,689

United States Patent and Trademark Office

Registered June 22, 1999

SERVICE MARK PRINCIPAL REGISTER



VALE NATIONAL TRAINING CENTERS, INC. (TEXAS CORPORATION)
P.O. BOX 6030
TYLER, TX 75711

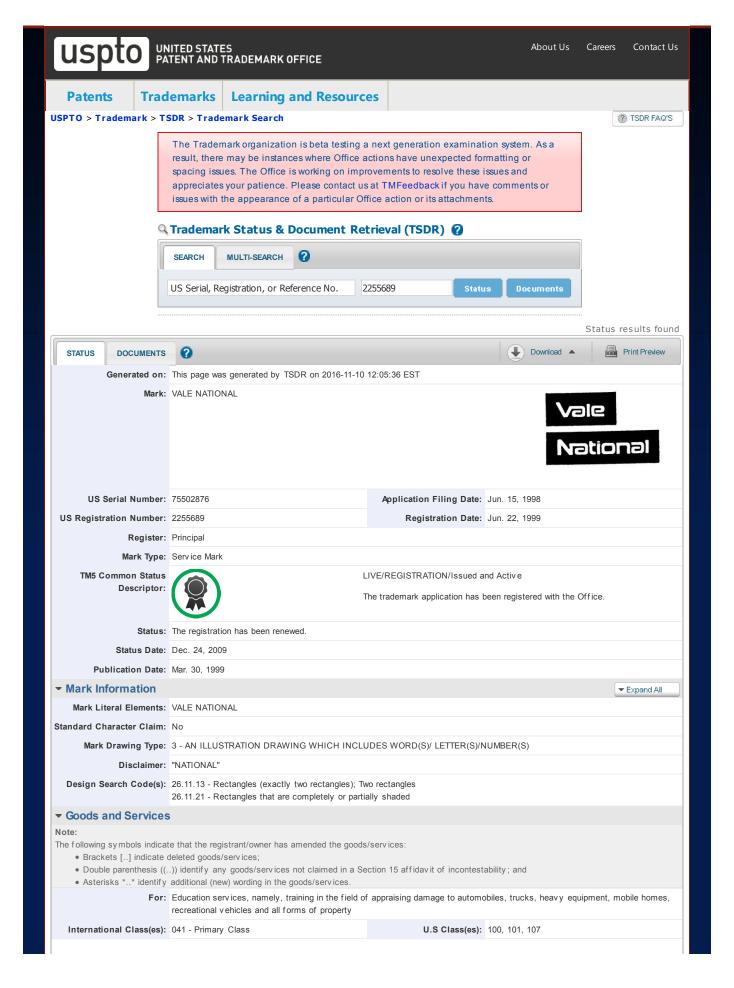
FOR: EDUCATION SERVICES, NAMELY, TRAINING IN THE FIELD OF APPRAISING DAMAGE TO AUTOMOBILES, TRUCKS, HEAVY EQUIPMENT, MOBILE HOMES, RECREATIONAL VEHICLES AND ALL FORMS OF PROPERTY, IN CLASS 41 (U.S. CLS. 100, 101 AND 107).

FIRST USE 0-0-1979; IN COMMERCE 0-0-1979.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "NATIONAL", APART FROM THE MARK AS SHOWN.

SER. NO. 75-502,876, FILED 6-15-1998.

SUSAN LESLIE DUBOIS, EXAMINING ATTORNEY



1 of 3 11/10/2016 11:06 AM

Class Status:	ACTIVE								
Basis:	1(a)								
First Use:	1979 Use in Commerce: 1979								
▼ Basis Information (Case Level)									
Filed Use:	Yes	Currently Us	e: Yes	Amended Use:	No				
Filed ITU:	No	Currently IT	U: No	Amended ITU:	No				
Filed 44D:	No	Currently 44l	D: No	Amended 44D:	No				
Filed 44E:	No	Currently 44	E: No	Amended 44E:	No				
Filed 66A:	No	Currently 66	A: No						
Filed No Basis:	No	Currently No Basi	s: No						
▼ Current Owner(s) Information									
Owner Name:	Vale National Training Centers, Inc.								
Owner Address:	2424 E. Randol Mill Rd Arlington, TEXAS UNITED STATES 76011								
Legal Entity Type:	CORPORATION		State or Country Where Organized:	TEXAS					
▼ Attorney/Correspondence Information									
Attorney of Record	rney of Record								
Attorney Name:	George R. Schultz		Docket Number:	27831.0108					
Correspondent									
·	GEORGE R SCHULTZ SCHULTZ & ASSOCIATES PC 5400 LBJ FREEWAY STE 1200 DALLAS, TEXAS UNITED STATES 75240								
Phone:	214 210 5940		Fax: 214 210 5941						
Domestic Representative - Not Found									
Prosecution History									
▼ Maintenance Filings	ance Filings or Post Registration Information								
Affidavit of Continued Use:	Section 8 - Accepted								
Affidavit of Incontestability:	Section 15 - Accepted								
Renewal Date:	Jun. 22, 2009								
▲ TM Staff and Location Information									
◆ Assignment Abstract Of Title Information - Click to Load									
Proceedings - Click	▲ Proceedings - Click to Load								

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